

and/or may submit arguments that the prior art references teach away from the claimed invention.

The applicants are continuing to gather further evidence to show that basalt and glass fibers were not considered equivalents, and such further evidence will be submitted when received. For the moment, however, the basic issue is whether the Examiner has established a prima facie case of obviousness based upon the facts of record.

The Examiner has rejected the claims in the application as being obvious in view of the combined teachings of the Arthurs and Michael references, either alone or in combination with other references. In response to that rejection, the application provided the supplemental Declaration of the inventor that was filed on March 6, 2007. However, the Examiner stated that this Declaration did not overcome the Examiner's prima facie case of obviousness for a variety of reasons. As described below, however, the reasons provided by the Examiner are without merit. Thus, the Declaration of the inventor does, in fact, overcome the Examiner's prima facie case of obviousness.

In Paragraphs 1 and 2 of the supplemental Declaration, facts are provided showing that there has been and continues to be a long felt need in the vehicular manufacturing industry to (1) reduce the overall weight of vehicles, (2) reduce the amounts of glass fibers that are used in vehicular components, and (3) recycle automotive parts at the end of their useful lives. The Examiner dismisses this portion of the supplemental Declaration by stating that although the supplemental Declaration contains certain facts regarding the declarant's own work and his personal knowledge of the work of others, it was deficient because it did not provide facts regarding "the scope of the work, how many companies this entailed, the amount of attention and resources which were focused on the problem, etc., has not been set forth in the form of factual evidence." This statement is respectfully traversed. The supplemental Declaration provides many facts that are based upon the first hand knowledge of the declarant, not merely opinions as suggested by the Examiner. The Examiner appears to suggest that because the declarant did not specifically provide certain additional

facts identified by the Examiner in the Office Action, then the supplemental Declaration is rendered unpersuasive. However, this approach incorrectly places the burden on the applicants to prove patentability. The Examiner is respectfully requested to consider the factual evidence that is presented in the supplemental Declaration based upon the first hand knowledge of the declarant and not dismiss such facts because other facts (not specifically known to the declarant) were not presented in the declaration.


In Paragraph 5 of the supplemental Declaration, facts are provided showing the unexpected benefits of reuse after incineration of the laminate product. The Examiner dismisses this portion of the supplemental Declaration by stating that this is merely "another advantage which would flow naturally from following the suggestion of the prior art." This statement is respectfully traversed. The supplemental Declaration provides specific facts in support of an unexpected benefit of the claimed invention. The Examiner has provided no evidence that this unexpected benefit "would flow naturally" from the prior art. On the contrary, the facts presented in the supplemental Declaration are important secondary considerations of non-obviousness that demonstrate why a person of ordinary skill would not have considered the invention to be obvious at the time the invention was made. Thus, the Examiner's refusal to accord weight to the supplemental Declaration is incorrect and should be reversed.

The Examiner further dismisses the significance of the press release by stating that the criteria used in deciding the award is not of record and that it was not clear that this criteria would be the same as the criteria used to determine novelty and obviousness by the PTO. This statement is simply incorrect. The significance of the press release is not based upon the criteria used to determine novelty and obviousness by the PTO. The significance of the press release is that it presents additional and important evidence regarding the secondary considerations of non-obviousness that demonstrate why a person of ordinary skill would not have considered the invention to be obvious at the time the invention was made. Thus, the Examiner's refusal to accord weight to the supplemental Declaration is incorrect and should be reversed.

In the supplemental Declaration, specific and unrefuted facts (again, the so-called secondary consideration of obviousness) are presented that show why a person of ordinary skill in the art would not combine the teachings of the references as proposed by the Examiner to achieve the claimed invention. The Examiner cannot simply dismiss such facts as being mere opinion. Rather, the Examiner must accept such facts in the absence of any evidence to the contrary.

For all of these reasons, it is submitted that the Examiner's prima facie case of obviousness has been fully rebutted by the supplemental Declaration. Accordingly, in the absence of any factual evidence that refutes the facts recited in the supplemental Declaration, the rejection of the claims must be withdrawn.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Richard S. MacMillan", written over a horizontal line.

Richard S. MacMillan

Reg. No. 30,085

MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, Fifth Floor
720 Water Street
Toledo, Ohio 43604
(419) 255-5900